

REMARKS

Claim Rejections- 35 USC § 112

In regards to claims 1-21 rejected under 35 USC § 112, the applicant cites *Beachcombers Int'l, Inc. v. WildeWood Creative Prods., Inc.*, 31 F.3d 1154, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994) In this case, the court stated “the relevant statute, 35 USC § 112 ¶ 2 (1988), requires that the claims particularly [point] out and distinctly [claim] the subject matter which the applicant regards as his invention.” “The operative standard for determining whether this requirement has been met is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Applicant's claim 1 contains language describing “a thumb support member (figure 1, number 125) being integrally connected to the first end of the handle (figure 1, number 120) in a substantially parallel relationship to a longitudinal axis of the handle” which refers to the line of connection between thumb support member (figure 1, number 125) and handle member (figure 1, number 120) following a line substantially parallel to the longitudinal axis of the handle and being on the outer periphery of the handle member and along the edge of the thumb support member at the junction between the two members (as shown in figure 1). The claim 1 further states “and protruding outwardly laterally along the inner edge near a distal end of the first end therefrom to a sensor tip portion (figure 1, number 130) having a

semi-spherical shape at its apex point; the sensor tip portion being adapted to apply direct pressure to predetermined treatment areas on the body; and the thumb support member (figure 1, number 125) being dimensioned to support the circumference of a user's thumb wherein while in use the user thumb rests in a natural position parallel (as shown in figure 4) to the plane of the palm." and describes the positioning of the thumb while in use (as shown in figure 4) as being parallel to the plane of the palm indicating the utility plane (figure 1, number 170) of thumb support member (figure 1, number 125) along with the line of connection could only share a parallel relationship with the longitudinal axis of the handle.

This is differentiated from the current invention of Seiver where the thumb is purposely positioned perpendicular to and centered on the longitudinal axis of the handle and configured for a different functionality.

102 REJECTIONS

Examiner noted that claims 1-6, 10, 12-17 were rejected as being anticipated by **Seiver**. The reference must describe every detail of the claimed invention. (See **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed Cir. 1983)). Additionally, the reference must adequately describe the claimed invention to put it in the public domain (See **In re Zenitz**, 333 F.2d 924, 142 USPQ 158, 160 (C.C.P.A. 1964)). The description must enable a person with ordinary skill in the art not only to comprehend the invention but also make it. (See **Paperless Accounting, Inc v. Bay Area Rapid Transit Sys.**, 804 F.2d at 665, 231 USPQ at

653) The reference must teach the claimed invention. (See *Ex parte Fujshiro*, 199 USPQ 36 (Pat. Off Bd. App. 1977)).

103 REJECTION

Examiner noted that claims 7, 11 and 18-21 were rejected under 103 by Seiver in view of Beaty.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990))

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination (See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)).

There must be some reason given the prior art why one of ordinary skill in the art would have been prompted to combine the teachings of the references to arrive at the claimed invention. (See *In re Regel* 188 USPQ

References that teach away cannot serve to create a prima facie case of obviousness. (See *In re Gurl;ey*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir 1994)) In If references taken in combination would produce a “seemingly inoperative device”, we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. (See *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244)

Obvious to try standard is an improper standard (See *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (C.C.P.A. 1967)) It is impermissible to use the claimed invention

as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. An obvious rejection cannot be based upon hindsight and the specific teaching must come from the prior art. (See *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 178, 1784 (Fed. Cir. 1992). The claimed invention must be considered as a whole.

Examiner's may not use as an element of the obvious rejection that one skill in the art would arrive at the invention trying different alternative structures or materials (See *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (C.C.P.A. 1967) that which is within the capability of one skilled in the art is not synonymous with obvious. Levensgood teaches that an obvious rejection cannot be predicated on the fact that one skilled in the art would have the capability to arrive at the invention. Thus, that one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound reasoning does not afford the basis for an obvious conclusion (See *Id.*, 123USPQ at 352).

Reflexology refers to the use of touch techniques on the reflex areas of the ears, hands, and feet that correspond to all the other parts of the body, including the glands and organs. As discussed in Figure 1, reflexology is adapted to stimulate pressure sensors or nerves within the hands and feet with the fingers as shown in Figure 2 with the thumb in its natural position. While a therapist is applying pressure they must feel the vibration, which is the proprioceptive sensitivity defined in Exhibit 3. With reflexology the therapist is stimulating the nerves of the hands and feet and needs to feel the vibration of the stimulation.

Sevier's invention does not function to support reflexology; it support soft skin injuries only. As shown in figure 2, the thumb support member face (66) is disposed directly below the handle and faces downwardly, and is incorporated into (62). (See column lines 35-40.) As described in Exhibit 4 soft tissue is muscles and joint. Seiver device is designed to be used for applying pressure directly to soft tissue injury as discussed in Exhibit 4. The edge of Sevier culminates into a straight

circular edge (64) to apply pressure to areas of the muscle to relieve swollen tissue underneath the skin in more of a stripping fashion as shown in Figure 17 of Sevier.

In the present invention, the edge is semi-spherical or round like the thumb to allow for the natural pressure on the nerve endings in the hands and the feet. Thus, the present invention is structured to function significantly different than the present invention

The upward surfaces (50) and (52) converge in linear planes and intersect each other. Downwardly facing surface (62) has a curved surface and (58) does not have a curved end. In column 8, lines 10-20, Sevier's device is grasped as a joystick with the thumb forced over the top edge of the device as shown in Figure 17. The present invention, a reflexology device, thumb support member has an indentation on the upper surface of the thumb support member that faces upward. The protrusion at the end follows the user to feel the proprioceptive feeling. Sevier's device does not have this protrusion; thus, a person cannot feel the proprioceptive feeling. While in use, Sevier thumb rest causes the user's thumb must be rotated and lie parallel to palm. The rotation of the thumb forces the thumb out of its natural position as shown in Figure 17. Thus, Seiver cannot be used for reflexology because it places pressure on the thumb interfering with the feeling of the vibration. Seiver does not discuss anywhere the feeling requirement of the vibrations of stimuli.

If Sevier lies perpendicular to the longitudinal axis of the device as claimed by the examiner then the present invention lies parallel. This change has been added.

The claims were amended to add the features of the thumb rest being in its natural position parallel to the palm and opposing the forefingers. The edge of the thumb rest as shown is semi-spherical or round like a natural thumb for applying pressure. These features are shown within Figures 6 and 7 of the present invention.

Applicant respectfully requests that the rejections be withdrawn. Alternately should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he/she is invited to telephone the undersigned.

Respectfully submitted:

A handwritten signature in black ink, appearing to read 'Delphine M. James', written over a horizontal line.

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